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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 924,129	08 07 2001	Martin C. Crossman	1894	2689

7590 03 31 2003

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[REDACTED] EXAMINER

TUCKER, PHILIP C

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1212

DATE MAILED 03 31 2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

V6

Application No.	CROSSMAN
924 179	
Examiner	Group Art Unit
P. TUCKER	1712

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE
OF THIS COMMUNICATION.

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MONTH(S) FROM THE MAILING DATE

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on _____

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- | | |
|---|---|
| <input checked="" type="checkbox"/> Claim(s) 1 - 19 | is/are pending in the application. |
| Of the above claim(s) _____ | is/are withdrawn from consideration. |
| Claim(s) _____ | is/are allowed. |
| <input checked="" type="checkbox"/> Claim(s) 1 - 19 | is/are rejected. |
| Claim(s) _____ | is/are objected to. |
| Claim(s) _____ | are subject to restriction or election requirement. |

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

Attachment(s)

- | | |
|---|--|
| <input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5 | Interview Summary, PTO-413 |
| <input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892 | Notice of Informal Patent Application, PTO-152 |
| Notice of Draftsperson's Patent Drawing Review, PTO-948 | Other |

Office Action Summary

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to teach that the starch is chosen to release the chemical at selected temperatures, or in particular at 60 degrees C.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 19, it is not clear how such chemicals are incompatible, or what causes such incompatibility.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-9, 11-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 89/04842.

WO '842 teaches a granular starch composition which comprises at least one chemical, such as waxes and soaps, which can be used in oil fields. The starch may be an octenyl succinic starch (see claims and page 6).

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7. Claims 1-5, 8, 9, 11-13, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Fanta et al. (6461999 B1).

Fanta teaches a granular starch composition which is used in well treatment, and which comprises a chemical such as a lubricant, which is made by the same process (see examples).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2765
March 24, 2003



PHILIP C. TUCKER
ART UNIT 1712